

## REMARKS

In the Office Action<sup>1</sup>, the Examiner took the following actions:

- (a) rejected claims 1-13 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention,
- (b) rejected claims 1 and 11 under 35 U.S.C. § 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements,
- (c) rejected claims 1, 2, and 7 under 35 U.S.C. § 102(b) as being anticipated by Davies et al. (U.S. Patent No. 6,308,234) ("Davies"),
- (d) rejected claims 3 and 4 under 35 U.S.C. § 103(a) as being unpatentable over Davies and further in view of Numano et al. (U.S. Pub No: 2003/0048258) ("Numano"), and
- (e) rejected claims 5, 6, 8, 9, 10, 12, and 13 under 35 U.S.C. § 103(a) as being unpatentable over Davies and further in view of Tsubouchi et al. (U.S. Patent No.: 6,297,794) ("Tsubouchi").

By this Amendment, Applicant amends claims 1 and 4 and cancels claims 3, 8, and 11-13.

Applicant respectfully traverses the rejections, as set forth below.

### Rejection under 35 U.S.C. § 112, second paragraph

The Examiner rejected the claims 1-13 under 35 U.S.C. § 112, stating:

Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1 and 11 read "a second system operable **independently** of the first system, the second system including, a second controller that executes communication with the **peripheral device via the interface...**" The listed claims state that the second system is operable independently of the

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<sup>1</sup> The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants declines to automatically subscribe to any statement or characterization in the Office Action.

first system, however make reference to a peripheral device that is claimed to be located in the first system being executed by the second controller located in the second system. (Office Action, p. 2)

Applicant notes that claims 3, 8, and 11-13 have been cancelled. Thus the rejection of these claims is moot.

Applicant has amended claim 1 by deleting “a peripheral device having an interface and being capable of outputting image data via the interface” from the first system and adding “a peripheral device provided in the housing, the peripheral device having an interface and being capable of outputting image data via the interface” to claim 1. Applicant submits that amended claim 1 now fully complies with 35 U.S.C. § 112.

The Examiner rejected the claims 1 and 11 under 35 U.S.C. § 112, second paragraph, stating:

Claims 1 and 11 are rejected under 35 U.S.C. § 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See M.P.E.P. § 2172.01. The omitted structural cooperative relationships are: Controller 1 and 2 to display controller 1 and 2. (Office Action, p. 2)

Applicant notes that claim 11 has been cancelled. Thus the rejection of this claim is moot.

Applicant respectfully directs the Examiner’s attention to amended claim 1, which calls for “a switch device that switches a destination of connection of the interface of the peripheral device from the **first controller** to the **second controller**, in response to a select signal supplied from the second controller” (emphasis added) and to original claim 7, which recites that “the switch device includes a switch circuit that electrically

connects the plurality of signal lines of the interface to one of the **first controller** and the **second controller**.” (emphasis added)

Applicant submits that the switch device described in amended claim 1 and original claim 7 sufficiently shows an essential structural cooperative relationship between the first controller and the second controller. Accordingly, claim 1, as amended, fully complies with 35 U.S.C. § 112.

Therefore, Applicant respectfully requests that the rejection of claim 1, and claims 2, 4, 5, 6, 7, 9, and 10 which depend therefrom, be withdrawn.

**Rejection of Claims 1, 2, and 7 under 35 U.S.C. § 102(b)**

The Examiner rejected claims 1, 2, and 7 under 35 U.S.C. § 102(b) as anticipated by Davies.

In order to properly establish that Davies anticipates Applicant's claimed invention under 35 U.S.C. § 102, each and every element of each of the claims in issue must be found either expressly described or under principles of inherency, in that single reference. Applicant respectfully traverses the rejection of claims 1, 2, and 7 under 35 U.S.C. § 102(b) as anticipated by Davies since Davies fails to teach each and every element of the claims.

Claim 1 recites “a switch device that switches a destination of connection of the interface of the peripheral device from the first controller to the second controller, in response to a select signal supplied from the second controller”.

In the Office Action, the Examiner states that Davies “teaches an information processing apparatus comprising...a second system...including a switch device that

switches a destination of connection of the interface of the peripheral device from the first controller to the second controller [25]." (Page 3, item 4(b)) This is not correct.

Davies states that "[o]n the board 100 is a PCI to PCI bridge 25, which interfaces a host CPU PCI peripheral bus 27 to a secondary, vision processing system PCI bus 26 included on the PCI extension board." (Col. 3, lines 55-58) Nothing in Davies suggests that bus bridge 25 is anything more than merely a connection device between two PCI buses. Thus, nothing in Davies suggests that bus bridge 25 is used for switching a connection destination of a peripheral device between first and second controllers.

Therefore, Davies fails to teach at least "a switch device that switches a destination of connection of the interface of the peripheral device from the first controller to the second controller, in response to a select signal supplied from the second controller," as recited in claim 1, and required by dependent claims 2 and 7. Accordingly, Davies does not anticipate claims 1, 2, and 7. Applicant therefore respectfully requests the Examiner to reconsider and withdraw the rejection of claims 1, 2, and 7 under 35 U.S.C. § 102(b) as anticipated by Davies.

#### **Rejection of Claims 3 and 4 under 35 U.S.C. § 103(a)**

The Examiner rejected claims 3 and 4 under 35 U.S.C. § 103(a) as being unpatentable over Davies and further in view of Numano. Applicant has canceled claim 3 and incorporated its limitations into claim 1, and has amended claim 4 to be dependent upon claim 1. Applicant respectfully traverses the rejection of claim 4 under 35 U.S.C. § 103(a) as being unpatentable over Davies and Numano, since a *prima facie* case of obviousness has not been established.

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in

the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)." M.P.E.P. 2142, 8<sup>th</sup> Ed., Rev. 4 (October 2005), p. 2100-134.

A *prima facie* case of obviousness has not been established because for at least the reason that Davies and Numano, taken alone or in combination, do not teach or suggest each and every element of Applicant's claims.

Claim 1 calls for a combination including, for example, "a switch device that switches a destination of connection of the interface of the peripheral device from the first controller to the second controller, in response to a select signal supplied from the second controller". Davies fails to teach or suggest at least this element of claim 1. The Examiner cited Numano as a teaching of "a power button", "an operation button", and "a power supply unit". Even assuming the Examiner's characterization of Numano is correct, Numano fails to cure the deficiencies of Davies, discussed above. That is, Numano also fails to teach or suggest "a switch device that switches a destination of connection of the interface of the peripheral device from the first controller to the second controller, in response to a select signal supplied from the second controller," as recited in claim 1, and required by dependent claim 4. The cited references, taken either alone or in any reasonable combination, thus fail to teach or suggest all elements of claim 1. For at least this reason, Davies and Numano therefore fail to support a *prima facie* case of obviousness. The rejection of claim 4, which requires all elements of base claim 1, under 35 U.S.C. § 103(a) as being obvious over Davies and further in view of Numano is thus improper and should be withdrawn.

**Rejection of Claims 5, 6, 8, 9, 10, 12, and 13 under 35 U.S.C. § 103(a)**

The Examiner rejected claims 5, 6, 8, 9, 10, 12, and 13 under 35 U.S.C. § 103(a) as being unpatentable over Davies and Tsubouchi.

Applicant notes that claims 8, 12, and 13 have been cancelled. Thus the rejection of these claims is moot. Claims 5, 6, 9, and 10 depend upon claim 1 and include all the limitations thereof.

Applicant respectfully traverses the rejection of claims 5, 6, 9, and 10 under 35 U.S.C. § 103(a) as being obvious from Davies in view of Tsubouchi. A *prima facie* case of obviousness has not been established for at least the reason that Davies and Tsubouchi, taken alone or in combination, do not teach or suggest each and every element of Applicant's claims.

As previously discussed, claim 1 calls for a combination including, for example, "a switch device that switches a destination of connection of the interface of the peripheral device from the first controller to the second controller, in response to a select signal supplied from the second controller". Davies fails to teach or suggest at least this element as recited in claim 1, and required by claims 5, 6, 9, and 10.

In the Office Action, pages 5 and 6, the Examiner cited Tsubouchi as a teaching of the specific limitations recited in claims 5, 6, 9, and 10. Even assuming the Examiner's characterization of Tsubouchi is correct, Tsubouchi fails to cure the deficiencies of Davies, discussed above. That is, Tsubouchi also fails to teach or suggest "a switch device that switches a destination of connection of the interface of the peripheral device from the first controller to the second controller, in response to a select signal supplied from the second controller," as recited in claim 1, and required by claims 5, 6, 9, and 10. The cited references, taken either alone or in any reasonable

combination, thus fail to teach or suggest all the limitations required by dependent claims 5, 6, 9, and 10. For at least this reason, Davies and Tsubouchi therefore fail to support a *prima facie* case of obviousness with respect to claims 5, 6, 9, and 10. The rejection of claims 5, 6, 9, and 10 under 35 U.S.C. § 103(a) as being obvious from Davies in view of Tsubouchi is thus improper and should be withdrawn.

Moreover, in the Office Action, page 5, item 9(iii), the Examiner asserts that Numano's description of EC/KBC 211 in paragraph [0032] teaches the limitations of a power supply unit in the information processing apparatus of the present invention. This is not correct.

Claim 1, as amended, recites "a power supply unit that is provided in the housing and supplies power to the first system in response to the power-on signal and supplies power to the second system and the peripheral device in response to the reproduction instruction signal." However, EC/KBC 211 of Numano only informs a CPU of the occurrence of a button event when a button 115 or 166 is depressed. EC/KBC 211 is not used for supplying power to a second system.

Thus, Numano does not teach or suggest at least "a power supply unit that is provided in the housing and supplies power to the first system in response to the power-on signal and supplies power to the second system and the peripheral device in response to the reproduction instruction signal," as recited in the amended claim 1, and required by claim 4.

The Examiner admitted in the Office Action, page 4, item 9, that Davies "fails to explicitly teach a housing wherein there exists a power button...an operation button...and a power supply unit that is provided in the housing and supplies power to

the first system in response to the power-on signal and supplies power to the second system and the peripheral device in response to the reproduction instruction signal."

Accordingly, Davies and Numano, taken either alone or in any reasonable combination, fail to teach or suggest all the limitations required by dependent claim 4. For at least this reason, Davies and Numano fail to support a *prima facie* case of obviousness with respect to claim 4. The rejection of claim 4 under 35 U.S.C. § 103(a) as being obvious over Davies in view of Numano is thus improper and should be withdrawn.

### **Conclusion**

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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